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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,792	03/30/2001	Eric Lee Jensen	DP-304351	9135

7590

04/08/2003

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EXAMINER

KRAMER, DEVON C

ART UNIT

PAPER NUMBER

3683

DATE MAILED: 04/08/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/822,792

Applicant(s)

JENSEN ET AL.

Examiner

Devon C Kramer

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Christopher P. Schwartz
PRIMARY EXAMINER

DETAILED ACTION

1) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2) Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Wulff et al (5632361).

Wulff et al provides a magnetorheological damper comprising: an inner tube (12) with a first end and a second end having an imperforate sidewall; a magnetorheological piston (3) disposed within and slidably engaging the inner tube; an outer tube (4) surrounding the inner tube, wherein the outer tube is in fluid communication with the inner tube; a valve (207) disposed proximate the first end of the inner tube and providing fluid communication between the tubes (please see column 3 lines 25-27); a rod (2) having a first end attached to the piston and having a second end extending outside the inner and outer tubes; inherently an electrode is disposed in the rod operatively connected to the piston to supply power to the coil; magnetically energizable passages (fig 2, 3, 5a). Please note that the electrode running to the coil has to run through the rod in order to maintain the operation of the damper. Clearly the upper portion of the outer tube of Wulff contains a gas.

Claim Rejections - 35 USC § 103

3) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3683

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wulff et al in view of Jensen et al.

Wulff et al lacks the specific valve claimed.

Jensen et al provides a valve including first and second discs (82, 54); a valve body (58) having at least one orifice and a spring (74, 90).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the valve of Wulff et al with the valve as taught by Jensen et al in order to further regulate the fluid flow through the passageways.

Response to Arguments

5) Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the inner tube of Wulff does not have an imperforate sidewall and that another tube is disposed between the inner and outer tubes. Column 3 line 25 states "subsidiary components, including a bottom valve, with which the present invention could be employed." The present invention is seen as figure 1 and the bottom valve is used as a subsidiary component in figure 1. Who is to say the orifice is part of the subsidiary components? The examiner takes the position that the inner tube of figure 1 does have an imperforate side wall. If there was an orifice the inventor would have depicted it in the figure. Applicant cannot argue hindsight because the examiner is solely using the reference to Wulff to reject the claims.

Conclusion

7) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devon C Kramer whose telephone number is 703-305-0839. The examiner can normally be reached on Mon-Fri 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3519 for regular communications and 703-308-3519 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1134.

DK
April 2, 2003

CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER
